

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WEIJIA WANG and NHAN T. NGUYEN

Appeal No. 2000-1594
Application No. 08/543,101¹

ON BRIEF

Before RUGGIERO, BLANKENSHIP and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-3, 5-19, 21 and 22, which are all of the claims pending in the present application.

We reverse.

BACKGROUND

Appellants' invention is directed to a two-way personal mobile terminal that receives in a receiver data signals from a

¹ Application for patent filed October 13, 1995.

high-power transmitter and communicates via a transceiver with a local cellularized base station. As depicted in figure 3a, the receiver demodulates the received data signal and provides the result to a central processing unit (specification, page 12). A second communication link is established with a local base station for a two-way communication using the same frequency for both transmitting and receiving data (specification, page 14).

Representative independent claim 1 is reproduced below:

1. A personal mobile terminal comprising:

a receiver for receiving a first data signal modulated by a first carrier frequency;

a transceiver for transmitting a second data signal modulated by a second carrier frequency and for receiving a third data signal modulated by said second carrier frequency; and

a central processing unit for controlling operations of said personal mobile terminal in accordance with a predetermined protocol, in which said personal mobile terminal receives a notification message at said receiver and, upon receiving said notification messages, initiates two-way data communication using said transceiver.

The following references are relied on by the Examiner:

Levanto et al. (Levanto)	5,175,758	Dec. 29, 1992
Krenz et al. (Krenz)	5,508,709	Apr. 16, 1996
		(filed Jan. 18, 1995)
Roach, Jr. et al. (Roach)	5,526,401	Jun. 11, 1996
		(filed Oct. 31, 1994)
Hara	5,553,317	Sep. 3, 1996
		(filed Sep. 17, 1992)

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Claims 1-3, 5-14, 16-19, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roach, Hara and Levanto.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Roach, Hara, Levanto and Krenz.

Rather than reiterate the viewpoints of the Examiner and Appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 11, mailed March 30, 1999) for the Examiner's reasoning, the appeal brief (Paper No. 10, filed February 22, 1999) and the reply brief (Paper No. 12, filed May 17, 1999) for Appellants' arguments thereagainst.

OPINION

With respect to the rejection of claims 1-3, 5-14, 16-19, 21 and 22, Appellants point out that Roach dismisses radiotelephone techniques as unsuitable for use in paging systems (brief, page 8). Additionally, Appellants assert that Roach attempts to avoid undesirable disruptions of a current activity when messages are received and to reduce the cost of the system by using existing components and transmitting only on the control channel of the cellular system (id.). Appellants argue that the Examiner's rejection ignores Roach's clear teachings regarding the use of existing equipment and incorporates the complex data modulation

of Hara and Levanto's cellular communication protocol (brief, page 8 and reply brief, page 2).

In response to Appellants' arguments, the Examiner asserts that Roach and Levanto relate to communication devices containing a paging receiver and a cellular transceiver (answer, pages 8 & 9). The Examiner further argues that the references can be properly combined because they represent "different ideas in the area of communication" (id.).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

A review of Roach reveals that the reference relates to a data messaging system for communicating data messages over the control channel of a cellular network. Roach further discloses that a paging receiver receives the data message from a paging

terminal (col. 33, line 66 through col. 34, line 1) and a conventional cellular transmitter transmits an acknowledge message via the control channel of the cellular network (col. 34, lines 24-33).

Hara discloses a radio telephone system that reduces channel to channel interference by using different carriers for both signal transmission and signal reception (col. 1, lines 49-58). Levanto, on the other hand, relates to a cellular telephone system in which the limited range of mobile units is overcome by using a combination of paging and cellular networks. Levanto stores paging messages in the exchange of the cellular network and communicates the stored messages with the mobile unit when the unit enters the paging range (col. 6, lines 24-47).

As the Federal Circuit states, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The court further reasons in Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001) that for an invention to be obvious in view

of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.

Based on these well-settled principles, we agree with Appellants that there is no reason or motivation to combine Roach's data communication system with the two-carrier communication system of Hara and Levanto's integrated cellular and paging system. The Examiner's assertion that Roach, Hara and Levanto provide "different ideas in the area of communication," is not sufficient to suggest the combination to one of ordinary skill in the art. Furthermore, the Examiner does not point to any particular part of the references to provide the required reason or suggestion for combining the references, nor can we derive this requirement from the teachings of the references. In that regard, Roach uses a cellular transmitter with a paging receiver and Levanto improves the range of cellular communication by storing paging messages in the cellular exchange while nothing in Hara points to the use of a two-carrier transmission/reception in combination with the data messaging system of Roach.

In view of our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness with

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respect to claims 1 and 16 because the necessary teachings and suggestions for combining Roach, Hara and Levanto are not shown. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of independent claims 1 and 16, nor of claims 2, 3, 5-14, 17-19, 21 and 22 dependent thereon.

We note that the Examiner relies on Krenz in combination with Roach, Hara and Levanto to reject claim 15 under 35 U.S.C. § 103(a). We find nothing in Krenz that is capable of curing the deficiencies noted above with respect to the rejection of claims 1 and 16. Accordingly, the 35 U.S.C. § 103 rejection of claim 15 over Roach, Hara, Levanto and Krenz is not sustained.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-3, 5-19, 21 and 22 under 35 U.S.C. § 103 is reversed.

REVERSED

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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HOWARD B. BLANKENSHIP)	APPEALS
Administrative Patent Judge)	AND
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MAHSHID D. SAADAT)	
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